

1 QUINN EMANUEL URQUHART & SULLIVAN, LLP

2 Sean Pak (Bar No. 219032)

3 seanpak@quinnemanuel.com

4 Melissa Baily (Bar No. 237649)

5 melissabaily@quinnemanuel.com

6 James Judah (Bar No. 257112)

7 jamesjudah@quinnemanuel.com

8 Lindsay Cooper (Bar No. 287125)

9 lindsaycooper@quinnemanuel.com

10 Iman Lordgooei (Bar No. 251320)

11 imanlordgooei@quinnemanuel.com

12 50 California Street, 22nd Floor

13 San Francisco, California 94111-4788

14 Telephone: (415) 875-6600

15 Facsimile: (415) 875-6700

16 Marc Kaplan (*pro hac vice*)

17 marckaplan@quinnemanuel.com

18 191 N. Wacker Drive, Ste 2700

19 Chicago, Illinois 60606

20 Telephone: (312) 705-7400

21 Facsimile: (312) 705-7401

22 *Attorneys for GOOGLE, LLC*

23 UNITED STATES DISTRICT COURT

24 NORTHERN DISTRICT OF CALIFORNIA, SAN FRANCISCO DIVISION

25 SONOS, INC.,

26 Plaintiff,

27 v.

28 GOOGLE LLC,

Defendant.

Case No. 3:20-cv-06754-WHA

Related to Case No. 3:21-cv-07559-WHA

**GOOGLE LLC'S RESPONSE TO
REQUEST FOR SUPPLEMENTAL
BRIEFING (DKT. 626) REGARDING
DERIVATION DEFENSE**

1 Google LLC (“Google”) files this brief pursuant to the Court’s Request for Supplemental
2 Briefing regarding the joint proposed final pretrial order and “whether there is a properly disclosed
3 derivation defense.” Dkt. 626 at 1. Although there is indeed a properly disclosed derivation defense,
4 Google is amenable to streamlining the issues for trial as explained below.

5 Sonos stated its position in the pretrial order (Dkt. 615) that “Google does not have a properly
6 disclosed derivation defense.” Dkt. 615 at 2, 5. But Google did properly disclose its derivation
7 defense, and Sonos never moved to strike it. Consistent with Google’s invalidity contentions,
8 Google’s invalidity expert, Dr. Schonfeld, opined that the Sonos Forums were prior art under 35
9 U.S.C. § 102(f). *See, e.g.*, Google’s Invalidity Contentions charts 885-5 and 966-5 (Dkt 602-7), Dr.
10 Schonfeld’s 2022.11.30 Op. Report at ¶ 175 (Dkt 602-8). An invalidity defense under § 102(f) is a
11 derivation defense, as it alleges that the inventor “did not himself invent the subject matter sought
12 to be patented.” Accordingly, Google stated its position in the pretrial order that the issues
13 remaining to be tried included “[w]hether Claims 1, 2, 4, 6, and 8 of the ’966 patent are invalid by
14 way of derivation” and “[w]hether Claim 1 of the ’885 patent is invalid by way of derivation.” Dkt.
15 615 at 8. As Google also indicated in its opposition to Sonos’s Motion *in Limine* No. 5 to exclude
16 accusations that Sonos acted improperly, Google intended to argue that Sonos derived the alleged
17 invention from the suggestions of its users who publicly posted the idea to add multiple zone scenes
18 to the existing Sonos prior art system on the Sonos Forums website before the alleged conception
19 date of the asserted patents. *See e.g.*, Dkt. 602-5 at 2-3.

20 Despite having properly presented and preserved its derivation defense, Google is
21 nevertheless willing to drop its derivation defense in an effort to narrow the scope of issues for trial.
22 However, Google still intends to utilize the Sonos Forums publications as prior art under §§ 102 and
23 103. In particular, Google will show that this prior art was (1) publicly available on Sonos’s website,
24 (2) may have been accessed by Sonos engineers, (3) rendered the claimed inventions obvious, (4) is
25 relevant to the level of skill in the art, and (5) disclosed aspects of the claimed invention prior to
26 Sonos’s claimed priority date. Google withdraws only its argument that the patents are invalid under
27 § 102(f) alone.

Respectfully submitted,

By /s/ Sean Pak
 Sean Pak
 Melissa Baily
 James D. Judah
 Lindsay Cooper
 Marc Kaplan
 Iman Lordgooei

Attorneys for Google LLC

CERTIFICATE OF SERVICE

The undersigned certifies that on May 3, 2023, all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document through the Court's CM/ECF system.

DATED: May 3, 2023

/s/ Sean Pak

Sean Pak